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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,848

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EXAMINER

NEWAY, BLAINE GIRMA

ART UNIT

PAPER NUMBER

4133

MAIL DATE

DELIVERY MODE

04/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,848	<b>Applicant(s)</b> METAYER ET AL.	
	<b>Examiner</b> BLAINE G. NEWAY	<b>Art Unit</b> 4133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

This is in response to application filed on May 13, 2005, in which claims 1-20 are presented for examination.

***Status of Claims***

Claims 1-20 are pending of which claim 1 is in independent form.

***Drawings***

The drawing (figure 5) is objected to under 37 CFR 1.83(a). The drawing must show every feature of the invention specified in the claims. Therefore, the "suspension means" must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claims 1, 2 and 6, the Examiner notes that the use of the term "suspension means" is confusing since it appears to invoke 35 U.S.C. 112, sixth paragraph but is not written in the proper format.

Regarding claims 5, 6, 10, 16 and 20 the limitations "the axis (X2)", "the first end (14)", "the second end (18)", "the axis (X1)", "means(19)" are recited in line 7 of claim 5, lines 5 and 6 of claim 6, lines 4 and 5 of claim 10, line 4 of claim 16 and line 5 of claim 20. Reference numerals within parentheses cannot be used as a substitute for clear recitation of structure.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "said second end (18)" in line 14 and "said wall (16) of the brake disc" in lines 10-11. There is insufficient antecedent basis for these limitations in the claims.

Claim 1 also recites the limitation "said housing (13) comprises at least one suspension means" .it is not clear whether the housing or the brake disc has the suspension means 15. For examination purposes the Examiner is assuming the suspension means and the shoulder are the same and are located in the housing.

Regarding claim 10, the orientation of "longitudinal axis (X1)" and "longitudinal axis (X2)" is not stated in the claim, making the claim indefinite.

Claims 11-16 and 18 recite the limitation "said element" or "the element". There is insufficient antecedent basis for these limitations in the claims.

Regarding claim 17, in lines 4-5, it is unclear what structure is being claimed by "grooves extend upwards". The Examiner notes that grooves have a depth and absent definition of a reference planes or axis or axes "upwards" and "downwards" have no meaning.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

As best understood by the Examiner in light of the 35 U.S.C. 112, second paragraph rejections, claims 1-6 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fenton et al (3,547,569) or Fenton herein.

In applying Fenton to claims 1-6 and 10-11, the examiner notes that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 1, Fenton discloses a storage element (capable of storing at least one appropriately sized brake disc) having at least one housing of longitudinal axis having:

an opening (with the intended use of inserting an appropriately sized brake disc) at a first longitudinal end, having an internal diameter greater than the external diameter of an appropriately sized brake disc;

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a wall connecting the first longitudinal end to a second longitudinal end;  
at least one suspension means or shoulder made in the wall so that a non-zero distance separates the shoulder and a first or second face of the appropriately sized brake disc, facing towards the second longitudinal end of the housing (See marked up figure 1).

Regarding claim 2, Fenton further discloses the suspension means or the shoulder (of width such that the shoulder collaborates with a radially external end of a first or second face of an appropriately sized brake disc) connecting a larger-diameter first cylindrical portion of the longitudinal axis (of a diameter greater than the diameter of the appropriately sized brake disc) and a smaller-diameter second portion of the longitudinal axis (see marked up figure 1).

Regarding claim 3, Fenton further discloses the shoulder being made of at least two parts arranged in one and the same plane and formed by angular sectors distributed, advantageously uniformly, over the periphery of the housing (see marked up figure 1).

Regarding claim 4, Fenton further discloses the housing having several shoulders arranged in parallel planes so that the storage element is capable of taking brake discs of different diameters (see marked up figure 1).

Regarding claim 5, Fenton further discloses each shoulder connecting a larger-diameter part to a smaller-diameter part, and the smaller-diameter part forming the next larger-diameter part, and in that each larger-diameter part has an axial dimension along the longitudinal axis capable of being at least equal to half the distance separating first and second faces of an appropriately sized brake disc (see marked up figure 1).

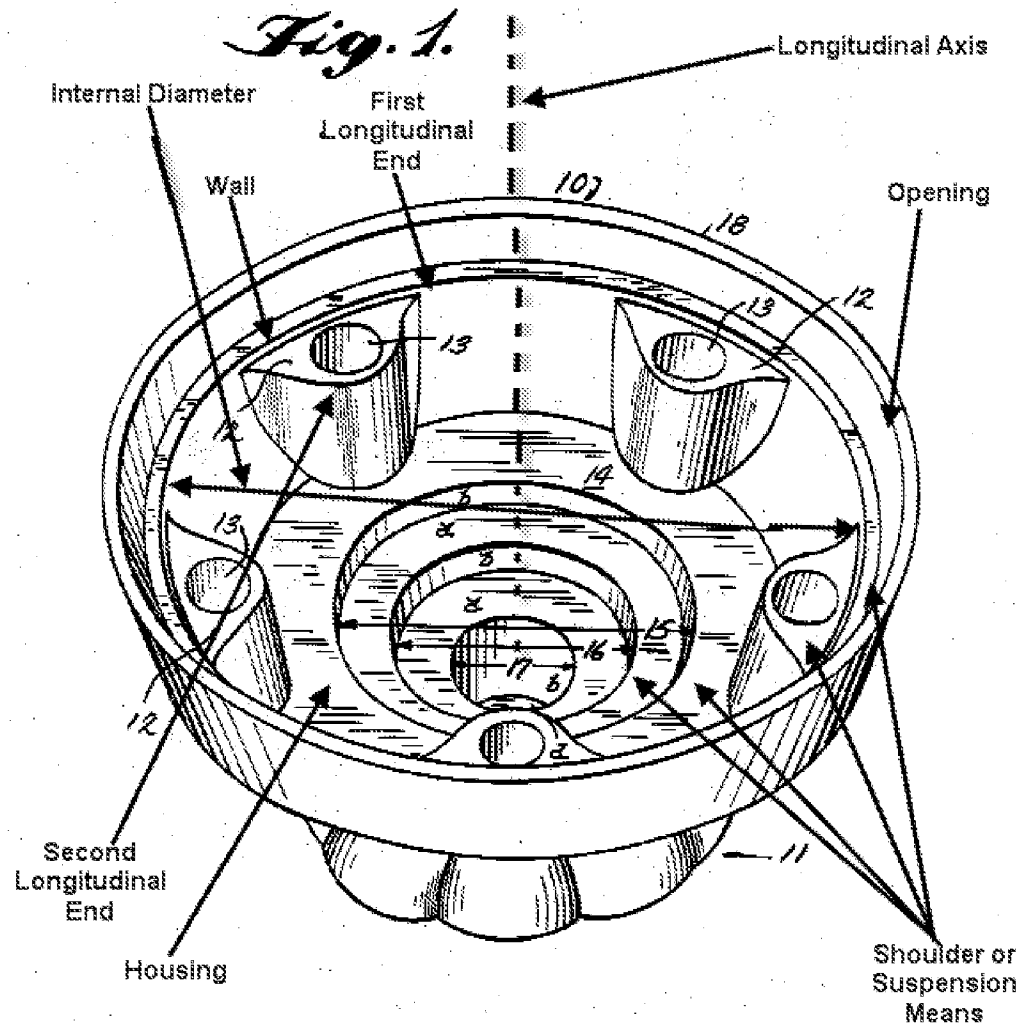
Regarding claim 6, Fenton further discloses the smaller-diameter portion of the suspension means along the longitudinal axis from the first longitudinal end of the housing towards the second longitudinal end forms the larger-diameter portion of a next suspension means (see marked up figure 1).

Regarding claim 9, Fenton further discloses the wall is in the form of a cone frustum with the taper directed towards the second longitudinal end of the housing (figure 3).

Regarding claim 10, Fenton further discloses the housing having a dimension along the longitudinal axis at least equal to the dimension of an appropriately sized brake disc along its longitudinal axis (figure 1).



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As best understood by the Examiner in light of the 35 U.S.C. 112, second paragraph rejections, claims 1, 9, 10, 11 and 14- 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston(4,722,440).

In applying Johnston to claims 1, 9, 10, 11 and 14- 20, the examiner notes that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 1, Johnston discloses a storage element (capable of storing at least one appropriately sized brake disc) having at least one housing 14 of longitudinal axis having:

- an opening (with the intended use of inserting an appropriately sized brake disc) at a first longitudinal end, having an internal diameter greater than the external diameter of an appropriately sized brake disc;

- a wall 22, 28 connecting the first longitudinal end to a second longitudinal end;

- at least one suspension means or shoulder 26 made in the wall so that a non-zero distance separates the shoulder and a first or second face of the appropriately sized brake disc, facing towards the second longitudinal end of the housing (figure 4).

Regarding claim 9, Johnston further discloses the wall 22, 28 being in the form of a cone frustum with the taper directed towards the second longitudinal end of the housing (figure 4).

Regarding claim 10, Johnston further discloses the housing having a dimension along the longitudinal axis at least equal to the dimension of an appropriately sized brake disc along its longitudinal axis (figure 4).

Regarding claim 11, Johnston discloses the storage element being fabricated of a plastic. The examiner notes that claim 11 is product-by-process claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 14 and 15, Johnston further discloses the storage element having six and 12 housings distributed uniformly and the shape of a rectangular parallelepiped (figure 1).

Regarding claims 16 and 17, Johnston further discloses The storage element having grooves 12 i.e. means with walls extending upwards in the direction of stacking on the rims of the storage element, allowing several elements to be stacked one on top of the other (figure 5).

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Regarding claims 18 and 19, Johnston further discloses the grooves 12 i.e. means are by blocks (made will top wall 24 and 8 side walls) formed as integral part of the housings, arranged centrally between several housings, advantageously between four housings. Johnston also discloses bearing surfaces 50, 52, 54, 56 projecting from the rims towards the inside of the storage element (for an additional element able to be stacked on the storage element) (figures 1 and 2).

Regarding claim 20, Johnston further discloses at least two storage elements stacked along the axis the longitudinal axis (figures 5 and 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As best understood by the Examiner in light of the 35 U.S.C. 112, second paragraph rejections, claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al (3,547,569) or Fenton herein.

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Fenton discloses the all elements of the claimed invention except for the width of the shoulder being preferably between 4 mm and 10 mm or more preferably being between 6 mm and 8 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the width of the shoulder between 6 mm and 8 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As best understood by the Examiner in light of the 35 U.S.C. 112, second paragraph rejections, claims, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (US 4,722,440).

Johnston discloses the storage element to be fabricated of a plastic material. Although Johnston does not specifically disclose the storage container to be made of ABS or Polyethylene, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have fabricated the storage element of Johnston, of ABS or Polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

W. H. Robinson et al (US 3,080,964)

H. W Gutsche et al (US 3,469,686)

Yung-Tsai Yen (US 4,470,508) all relate to packaging with steps inside the housing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAINE G. NEWAY whose telephone number is (571)270-5275. The examiner can normally be reached on M-F 7:30 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on 571 272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blaine G Neway/  
Examiner, Art Unit 4133

4/10/2008

/Frantz Coby/  
Supervisory Patent Examiner  
Art Unit 4133